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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/384,380	08/27/1999	MICHEHISA TASAKA	0234-0370P	7724

2292 7590 01/23/2004

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EXAMINER

LEE, RJP A

ART UNIT

PAPER NUMBER

1713

DATE MAILED: 01/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.	Applicant(s)	
09/384,360	TASAKA ET AL.	
Examiner	Art Unit	
Rip A. Lee	1713	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 12 December 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY (check either a) or b))

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action, or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
 2. ☒ The proposed amendment(s) will not be entered because:
 (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ they raise the issue of new matter (see Note below);
 (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
 4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
 6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
 7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1-3, 5-7 and 10-15.

Claim(s) withdrawn from consideration: _____

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
 9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
 10. ☒ Other: attachment to advisory action

Attachment to Advisory Action

This advisory action follows a response filed on December 12, 2003. Applicants' arguments have been considered, but they are not persuasive. Applicants submit that there is no motivation to combine references. However, a *prima facie* case of obviousness has been established properly according to the three guidelines set forth in MPEP § 2142. This has been shown conclusively in previous office actions and need not be discussed here.

Applicants also state that there is no apparent reason to treat an inorganic flame retardant as opposed to treating inorganic filler. Yet, this is merely a matter of nomenclature. Magnesium hydroxide is magnesium hydroxide, whether it is called filler, flame retardant, opacifier, viscosity modifier, *etc.* The fact is, one having ordinary skill in the art would find it obvious to treat incompatible filler with coupling agent so that uniform dispersion into a base resin may be achieved. Such a notion is well-established and routine practice in the art.

Applicants' data from the declaration have been reviewed. One observes clearly that greater than 50 % of the surface of the filler must be treated with vinyl silane in order to achieve acceptable tensile strength. For comparison, example 1 contains filler with no vinyl silane, and example 101 contains filler with only 40 % of surface treated with vinyl silane. Indeed, these samples exhibit poor tensile strength.

A discussion of Example 1 is instructive. Here, the sample contains filler with complete surface treatment of vinyl silane coupling agent. The resulting composition displays excellent tensile strength properties.

Example 1 is representative of the embodiment made obvious from the combined teachings of Tasaka *et al.* in view of Aida *et al.* The skilled artisan, having read both references, would have found it obvious to use vinyl silane coupling agent to treat $\text{Mg}(\text{OH})_2$. It is further maintained that the skilled artisan would have found it obvious to treat the entire surface of filler in order to achieve uniform dispersion. That is, absent any teaching, it is argued that the skilled artisan would not find it obvious to treat the filler with anything less than 100 % coupling agent, especially with the objective of achieving uniform dispersion of filler in mind. If it is obvious to treat only a portion of filler, then it has not been made clear by Applicants.

In summary, it would have been obvious to one having ordinary skill in the art to treat the entire filler with vinyl silane coupling agent, and this amount more than satisfies the recited minimum of "50 parts by weight or more" or "at least half."

In view of this and previous discussions, the rejection of record has not been withdrawn.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rip A. Lee whose telephone number is (571)272-1104. The examiner can be reached on Monday through Friday from 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached at (571)272-1114. The fax phone number for the organization where this application or proceeding is assigned is (571)273-1104.

ral

January 12, 2004


DAVID W. WU
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